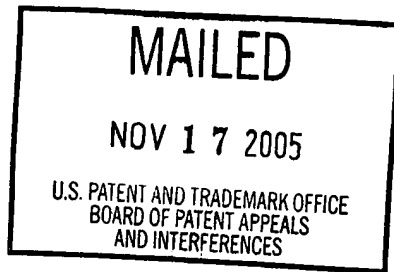


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte ALAN B. SHUEY

Appeal No. 2005-1208
Application No. 10/029,087

ON REQUEST FOR REHEARING

Before PATE, NASE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON REQUEST FOR REHEARING

This is a decision on the appellant's "REQUEST FOR REHEARING UNDER 37 CFR 1.197(B)," filed September 13, 2005, which is treated as a request for rehearing under 37 CFR § 41.52(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) of our earlier decision in this application mailed August 31, 2005. In that earlier decision we affirmed the examiner's decision rejecting claims 20-23 under 35 U.S.C. § 103 as being unpatentable over Facey in view of Pasbrig.

The appellant alleges in the request that this panel misapprehended or overlooked the contents of International Application publication WO 97/36123¹ (hereinafter WO 97/36123), referred to in Facey, in analyzing the appellant's argument that Facey teaches away from the combination of Facey in view of Pasbrig. In this regard, the appellant's request (page 2) states that WO 97/36123 discloses use of a tool (rod-like tool 31 in Figures 1-5) and "also discloses the use of a screw fixed to the wedging means and extending to the outside of the housing (Figures 9, 10, 11, 14, 15, 16, 17, 18, 19, 20, and 21)." In light of such disclosure, the appellant urges that the statement in column 2, lines 31-34, of Facey quoted on page 6 of our decision and on page 2 of the appellant's request

can be construed by a person of ordinary skill in the art to teach that the a [*sic*] separate tool is preferred over the other embodiment shown in WO 97/36123 which is the use of a screw fixed to the wedging means and extending outside of the housing. This would discourage a person of ordinary skill in the art from using a release lever fixed to the wedging means as taught by Pasbrig [request, pages 2-3].

As detailed below, the appellant's argument is flawed in several respects.

First, the appellant has materially mischaracterized the disclosure of WO 97/36123. The screw 39 disclosed therein is not fixed to the wedge 27. Rather, akin to the rod-like tool 31 of Figures 1-5, the screw 39 is provided with a necked tip 40 at one end rotatably engaged with the undercut groove 29 in the wedge 27. With an undercut

¹ The appellant appended a copy of this reference with the request.

groove 29 of dovetail cross-section, as shown in Figures 9 and 10, the necked tip of the screw 39 has a frustoconical form. If, alternatively, the undercut groove has a T cross-section, as illustrated in Figures 7 and 8, the necked tip would have a head "engaged with the wider part of the groove and a neck connecting the head with the rest of the screw and passing through the narrower part of the groove" (page 10). This, of course, is in contrast to the appellant's release levers 16 or 36 which are fixed to wedges 40 and to Pasbrig's handles 10, 10' attached to axial projections 6 or 9' and 9" fixed to clamping unit 5"" or 5 or 9.

Second, the statement at issue in column 2, lines 31-34, of Facey never specifies that the kit be preferably provided with a separate tool, as opposed to a handle or lever fixed to the wedge, for example. Rather, the statement simply refers to "a tool." Accordingly, it is, to say the least, difficult to find in such statement a teaching away from a handle or lever fixed to the wedge.

Third, even assuming that the statement at issue in Facey were construed by one of ordinary skill in the art as a preference for a separate tool which is not fixed to the wedge over one which is fixed to the wedge, a mere preference for one type of tool over another does not necessarily constitute a teaching away. The use of the term "preferably" in fact implies that other alternatives, while perhaps less favored, are possible. A reference is not limited to its preferred embodiment, but must be evaluated for all of its teachings, including its teachings of non-preferred embodiments. In re Burckel, 592 F.2d 1175, 1179, 201 USPQ 67, 70 (CCPA 1979). A reference "teaches

away" when it states that you cannot or should not use a specific embodiment. See Para-Ordnance Mfg., Inc. v. SGS Imps. Int'l Inc., 73 F.3d 1085, 1090, 37 USPQ2d 1237, 1241 (Fed. Cir. 1995). This is not the case with Facey.

It should be apparent from the above discussion that the appellant's request for rehearing has not persuaded us that our earlier decision should be modified.

Accordingly, the appellant's request has been granted to the extent that we have reconsidered our earlier decision but is denied with respect to making any modification thereto. The rejection of claims 20-23 under 35 U.S.C. § 103 as being unpatentable over Facey in view of Pasbrig remains affirmed.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

DENIED



WILLIAM F. PATE, III
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

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JDB/ki